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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,015	06/25/2001	Lionel Breton	016800-450	9059

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EXAMINER

BERKO, RETFORD O

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,015

Applicant(s)

BRETON ET AL.

Examiner

Retford Berko

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 27, 32, 37, 52, 62-64, 69, 81-82, 85, 88-114, 117-118, 121-122, and 125 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 27, 32, 37, 52, 62-64, 69, 81-82, 85, 88-114, 117-118, 121-122 and 125 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

Art Unit: 1615

DETAILED ACTION

Acknowledgement: Applicant's Request For Continued Examination (RCE) filed April 5, 2004 is acknowledged.

Status of Claims

1. Claims 1-26, 28-31, 33-36, 38-51, 53-61, 65-68, 70-80, 83-84, 86-87, 115-116, 119-120 and 123-124 have been cancelled in view of the amendment and pursuant to the RCE.
2. The claims currently under examination are: claims 27, 32, 37, 52, 62-64, 69, 81-82, 85, 88-114, 117-118, 121-122 and 125. The claims contain previously presented claims as well as modified claims. As such, the Examiner to whom Reexamination responsibility has been assigned subjected the claims to a new search and a review independent of the previous office actions.

Joint Inventors

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections-35 USC Sec 112

1. Claims 32, 114-118, 121, 122 and 125 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1615

A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

In the instant claims, the subject matter of the claims is directed toward a composition comprises cinnamic acid and its derivatives. According to the claims, the composition comprises at least one other product which stimulates collagen or lipid synthesis or comprises an agent for modifying skin proliferation". The examiner, in giving the broadest interpretation to the claims, considers the claims to be indefinite because the claims do not define the specific agent(s). The rationale for the rejection of the claims is to prevent the claims as currently worded not to read on any agent(s) capable of stimulating collagen synthesis, lipid synthesis or inducing cell proliferation. To overcome the rejection, applicant is advised to specify the agent(s) having the biochemical effects as claimed.

2. Claims 27, 82, 85, 88, 93 96, 102 and 108, are interpreted to provide for the use or intended use of cinnamic acid and its derivatives for stimulating collagen synthesis, lipid synthesis and prevent skin wrinkling and premature ageing of the skin. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. In the instant case, claims 1-17 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections-Sec 102

Art Unit: 1615

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Blank et al (US 5, 837, 694).

Claim 27 is directed toward a cosmetic composition comprising (a) cinnamic acid or a mixture of cinnamic acid and at least one derivative of cinnamic acid (e.g. polyhydroxycinnamic acid, cinnamic aldehyde or cinnamic alcohol); wherein the amount of cinnamic acid is 10^{-6} to 0.01 wt/%; and (b) a cosmetic carrier.

Blank et al (Patent '697) teach a cosmetic composition comprising 0.01-50 wt/% cinnamic acid and/or derivatives of cinnamic acid (dihydro cinnamic acid or trihydrocinnamic acid (abstract, col9, lin 35-40, col 11, lin 31, col 12, lin 67 and col 16, lin 20-25).

Claim 27 is anticipated by Patent '697.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 1615

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 27, 32, 37, 62, 69, 82, 85, 88-114, 117-118, 121-122 and 125 are rejected as unpatentable under 35 U.S.C. 103(a) over Blank et al (US 5, 837, 697) in view of the combination of Schaaf et al (US 2, 791, 534), Bobrove et al (US 5, 962, 505) and Galey et al (US 5, 536, 500).

Claims 27, 32, 37, 62, 69, 82, 85, 88-114, 117-118, 121-122 and 125 are directed toward cosmetic composition comprising (a) cinnamic acid or a mixture of cinnamic acid and at least one derivative of cinnamic acid (e.g. polyhydroxycinnamic acid, cinnamic aldehyde or cinnamic alcohol); wherein the amount of cinnamic acid is 10^{-6} to 0.01 wt/%; and (b) a cosmetic carrier. The claims are also directed toward the composition wherein an ingredient is an agent that stimulates collagen or lipid synthesis, vitamin C; and wherein the cinnamic acid present is 10^{-3} to 0.01 wt/% (up to 10.0 wt/%).

Blank et al (Patent '697) teach a cosmetic composition comprising 0.01-50 wt/% cinnamic acid and/or derivatives of cinnamic acid (dihydro cinnamic acid or trihydrocinnamic acid (abstract, col 9, lin 35-40, col 11, lin 31, col 12, lin 67 and col 16, lin 20-25).

Patent '697 does not teach the relationship between cinnamic or its derivatives and the treatment effect the compounds may have on application of a composition containing cinnamic acid or the advantages of using a composition comprising such ingredients.

Schaaf et al (Patent '534) discloses a cosmetic composition comprising cinnamic acid and Peru balsam (col 1, lin 30-45. It is generally known in the art that the components of Balsam of

Art Unit: 1615

Peru include compounds such as cinnamic acid, cinnamic anhydride, cinnamic alcohol; etc.

According to Schaaf, the cosmetic composition comprises pregnelone and its derivatives and that the composition confers advantages for use in that the ingredients stimulate the growth of the epidermis and cell proliferation; thus the inventors point out that the composition is useful for treatment and care of the skin (col 1, lin 1-28).

Bobrove et al (Patent '505) disclose a method of treating hot flashes in menopausal women. According to Bobrove, patients susceptible to hot flashes at menopause are treated with topical composition comprising cinnamic acid (col 4, lin 11-34). Though the composition disclosed is a pharmaceutical composition, formulations such as ointment, topical cleansers, creams and skin gels formulations are also available (col 4, lin 50-58).

Galey et al (Patent '500) is relied upon for the disclosure of cosmetic composition comprising cinnamic acid or of one of its derivatives and Vitamin C as ingredients (col 2, lin 10-15). Patent '500 discloses the advantage of the composition—i.e. the ingredients provide anti-oxidant properties and the contribution of the vitamin to synthesis of collagen (col 1, lin 1-25 and col 2, lin 10-15).

One of ordinary skill in the art would have been motivated to make a cosmetic composition comprising cinnamic acid, and mono- or dihydrocinnamic acid as ingredients; as according to the prior art cited. One of ordinary skill would expect reasonable level of success as in the prior art and thereby derive the known advantages and benefits of using such composition (i.e. stimulate growth of skin epidermis; Patent '534 at col 1, lin 25 and enhance collagen synthesis; Patent '500, col 1, lin 10-25). Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill at the time it was made.

Art Unit: 1615

Claims 27, 37, 52, 63, 64, 69, 82, 85, 88-114, 117-118, 121-122 and 125 are rejected as unpatentable under 35 USC 103(a) in view of Blank et al (US 5, 837, 697) further in view of Bissett et al (US 5, 487, 884) and further in view of Lanzendorfer et al (US 5, 952, 373; filed September 8, 1997).

The claims are directed toward cosmetic composition comprising (a) cinnamic acid or a mixture of cinnamic acid and at least one derivative of cinnamic acid (e.g. polyhydroxycinnamic acid, cinnamic aldehyde or cinnamic alcohol); wherein the amount of cinnamic acid is 10^{-6} to 0.01 wt/%; and (b) a cosmetic carrier. The claims are also directed toward the composition wherein an ingredient is an agent that stimulates collagen or lipid synthesis, vitamin C and phenylacetic acid; and wherein the cinnamic acid present is 10^{-3} .

The disclosures of Blank et al (Patent '697) were discussed: the disclosure of cosmetic composition comprising 0.01-50 wt/% cinnamic acid and/or derivatives of cinnamic acid (dihydro cinnamic acid or trihydrocinnamic acid (abstract, col 9, lin 35-40, col 11, lin 31, col 12, lin 67 and col 16, lin 20-25).

Patent '697 does not teach the use of phenylacetic acid as ingredient in the cosmetic composition.

Bissett et al (Patent '884) disclose a photoprotection composition useful for topical application (abstract and col 4, lin 50). According to Bissett, the composition comprises conventional sun screening agents including cinnamic acid derivatives (dihydroxy cinnamic acid and trihydroxycinnamic acid and derivatives; col 17, lin 1-20; vitamin C (col 21, lin 55-60). More importantly, Patent '884 discloses that the composition comprises chelating agents such as 2-hydroxyphenylacetic acid (col 38, lin 50-55), that the chelating agent works in the skin to

Art Unit: 1615

prevent damaging reactions in the skin and that it also protects the skin from the effects of UV radiation as well as from premature aging (col 11, lin 20-35; lin 50; col 22, lin 15).

One of ordinary skill would have been motivated to prepare a cosmetic composition comprising cinnamic acid and include as ingredients vitamin C and chelating agents such as phenylactic acid. One of ordinary skill would expect to obtain a composition that can be effective as topical photoprotection composition in order to prevent the damaging effects of UV rays on the skin caused by chronic exposure. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill at the time it was made.

A. The following prior art reference is cited for the record only as pertinent to applicant's claims but is not relied upon for the rejection of claims in this office action: Kalish et al (US 6, 713, 250). The reference is relied upon to show the ingredients in Balsam of Peru because the reference states the components of Peru of Balsam include cinnamic acid, cinnamic anhydride, cinnamic alcohol, vanillin and eugenol. The reference is pertinent because one of the prior art references used in the current rejections above; i.e. Schaaf et al; US 2, 791, 534; discloses that the cosmetic composition comprises cinnamic acid and Peru of Balsam. However, Patent '250 is not currently relied upon because the reference does not disclose cosmetic composition.

B. Derwent 1993-402027: the reference discloses that beta-phenylacrylic acid (i.e. 3-phenylpropenoic acid or cinnamic acid) is useful as an intermediate in the manufacture of cosmetics. The reference is not relied upon the disclosure is only considered ancillary or anecdotal.

C. Breton et al (FR002772612A1): the reference discloses a cosmetic composition comprising cinnamic acid; said composition is for reducing effects of menopause on collagen. The reference is not relied upon as it is non-specific as to the derivatives of cinnamic acid.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Retford Berko** whose telephone number is 571-272-0590. The examiner can normally be reached on M-F from 8.00 am to 5.30 pm. Examiner Berko has been assigned future prosecution of the application.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Thurman K Page**, can be reached on 571-272-0602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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